COUNSEL LISTED ON SIGNATURE PAGES

UNITED STATES DISTRICT COURT

FOR THE NORTHERN DISTRICT OF CALIFORNIA

SAN JOSE DIVISION

In re ACACIA MEDIA TECHNOLOGIES CORPORATION PATENT LITIGATION	Case No. 05 CV 01114 JW MDL No. 1665 **JOINT REPORT OF THE NEW YORK MDL CASES RE THE MDL PROCEEDINGS** **DATE:** N/A **TIME:** N/A **CTRM:** Hon. James Ware

Dockets.Justia.com

Pursuant to the Court's request, counsel for plaintiff, Acacia Media Technologies Corporation ("Acacia"), and counsel for defendants Time Warner Cable Inc. ("TWC"), Insight Communications, Inc. ("Insight"), Bresnan Communications ("Bresnan"), and CSC Holdings, Inc. ("CSC Holdings") (hereinafter collectively "the New York defendants") on Monday, November 14, 2005, submitted a *Joint Statement Re the Status of the New York MDL Cases and Transfer to this Court*. At that time, the parties requested the Court permit the parties to file this Joint Report.

I. JOINT STATEMENT OF STATUS OF NEW YORK MDL CASES

The parties set forth the status of the New York MDL cases in their Joint Statement dated Monday, November 14, 2005. In summary, no substantive action occurred in any of the New York MDL cases.

II. JOINT STATEMENT REGARDING STIPULATION TO STAY THE NEW YORK CASES

Presently, the Court has taken under submission the Motions for Reconsideration of the Court's July 12, 2004 Markman Order ("Markman Order"). The New York cases have not yet been transferred to this Court, and therefore none of the New York defendants participated in or were heard with respect to either the Court's previous claim construction rulings (as reflected in the Markman Order) or the Motions for Reconsideration. Once the New York defendants' cases are formally transferred to this Court, there are essentially two options with respect to the previous claim construction proceedings. (1) The New York defendants could be bound by the Markman Order and the Court's rulings on the pending Motions for Reconsideration, without them having had any opportunity to be heard, other than upon a motion by the New York Defendants for reconsideration of the Court's ruling, which would be subject to the requirements for bringing such a motion pursuant to Local Rule 7-9 and subject to the New York defendants' right to place their objections on the record at the appropriate time to preserve their rights on appeal. The New York Defendants contend that this option would unfairly prejudice them. (2) The Court could conduct a third round of claim construction proceedings on the same claim terms for the benefit of the New York defendants. Acacia contends this option would significantly delay the MDL proceeding, particularly in view of the fact that at least some of the New York defendants are also asking to be heard on many of the claim terms that were construed in the Markman Order but which were not challenged in the pending Motions for Reconsideration. This would impede Acacia's ability to move the MDL proceeding along with respect to the defendants currently active in the MDL proceeding before this Court.

Accordingly, Acacia and the New York defendants have agreed-in-principle to a stay of the two New York cases, including a stay of any action before this Court, until the first of the following events occurs:

1. Judge Ware transfers all of the pending MDL cases involving any cable defendant to their transferor courts; or
2. Judge Ware enters final judgment pursuant to Rule 54 of the Federal Rules of Civil Procedure in any MDL case against any party with respect to the issue of validity or enforceability or against any party in any MDL case with respect to infringement by any cable defendant. Judgment entered on the consent of any of the parties shall not constitute "final judgment" for purposes of the preceding sentence unless such judgment is for purposes of immediate appeal and such appeal is taken; or
3. All claims against all cable defendants are dismissed pursuant to settlement agreements.

It is the intent of the parties that there will be no proceedings between the New York defendants and Acacia regarding U.S. Patent Nos. 5,132,992, 5,235,275, 5,550,863, 6,002,720, or 6,144,702 until that time, and that the New York defendants not be bound by the Markman Order, the Court's ruling on the currently-pending Motions for Reconsideration or any other rulings by the Court during the pendency of the stay.

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The parties are currently working on the language of the stipulation for a stay and will file the stipulation as soon as the parties complete the stipulation and as soon as the New York cases are transferred to this Court and are assigned a N.D. California case number.

DATED: November 18, 2005

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) SS.
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I am employed in the County of Los Angeles, State of California. I am over the age of 18 years and not a party to the within action; my business address is 601 South Figueroa Street, Suite 3300, Los Angeles, California 90017.

On **November 18, 2005**, I served a copy of the within document(s) described as **JOINT REPORT OF THE NEW YORK MDL CASES RE THE MDL PROCEEDINGS** by transmitting via United States District Court for the Central District of California Electronic Case Filing Program the document(s) listed above by uploading the electronic files for each of the above listed document(s) on this date, addressed as set forth on the attached Service List.

The above-described document was also transmitted to the parties indicated below, by Federal Express only.

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3 copies

I am readily familiar with Hennigan, Bennett & Dorman LLP's practice in its Los Angeles office for the collection and processing of federal express with Federal Express.

Executed on **November 18, 2005**, at Los Angeles, California.

I declare that I am employed in the office of a member of the bar of this court at whose direction the service was made.

/s/ Sylvia A. Berson
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